

REMARKS

Claims 5-10 and 24 are pending in this application with claims 5-10 withdrawn from examination. This Amendment will cancel claims 5-10 as directed to non-elected subject matter. Upon entry of this Amendment, Applicants expressly reserve the right to pursue protection of any canceled subject matter in a subsequent application. No new matter will be introduced by this Amendment, and no new issues are raised.

Entry of this Amendment after final action is appropriate because it is believed to place the claims in a condition for allowance. Moreover, entry of this Amendment would reduce the number of claims, remove the canceled subject matter from consideration and, thereby, simplify issues for appeal.

Upon entry of the foregoing claim amendments, **claim 24 will be pending in this application**. Consideration of the claim amendments herein and reconsideration of the rejection under 35 U.S.C. 102(e) are requested.

Telephone Interview:

Applicants thank Examiner Mosher for the courtesy of a telephone interview with their representative, Debra A. Gordon, on June 9, 2006. During the telephone conference, the SARS coronavirus (SARS-CoV), Urbani strain genomic sequence listed in Rappuoli *et al.* (WO 2004/092360), which forms the basis for the Office's only remaining claim rejection under 35 U.S.C. 102(e), was discussed. Applicants' representative explained that Rappuoli *et al.* admit that the subject sequence was obtained from the Centers for Disease Control ("CDC") website. Thus, the Rappuoli *et al.* reference itself proves derivation of the described sequence from the present inventors, some of whom are expressly named on the CDC website posting cited by Rappuoli *et al.* Accordingly, the sequence as reported in Rappuoli *et al.* is not "by another" as required by 35 U.S.C. 102(e), and cannot support a rejection under that section.

The Examiner agreed that Rappuoli *et al.* described the SARS coronavirus (SARS-CoV), Urbani strain genomic sequence derived from the "authors" as listed on the CDC website posting. However, the Examiner noted that the inventive entity for the present application and

the listing of authors on the CDC website posting differed. Thus, even if Rappuoli *et al.* derived the subject sequence from inventors who were also listed as authors, the CDC website posting could serve as the basis for a subsequent rejection under 35 U.S.C. §102(a) because the “authorial entity” differed from the “inventive entity.” The Examiner recommended filing a declaration under 37 C.F.R. §1.132 from a “knowledgable person” to set forth the facts surrounding (i) derivation of the SARS coronavirus (SARS-CoV), Urbani strain genomic sequence by Rappuoli *et al.*, and (ii) the differences between the inventors of the claimed subject matter and the listing of authors on the CDC website posting.

Applicants thank the Examiner for her helpful guidance, and believe this Amendment conforms to the spirit of the discussion in the interview.

Claim Rejection:

Claim 24 has been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Rappuoli *et al.* (WO 2004/092360). Applicants traverse this rejection, at least, for reasons previously presented.

The Office contends that the sequence shown in Figure 501 of U.S. Provisional Application 60/464,109 (to which Rappuoli *et al.* claims priority) “appears to be the same as applicant’s SEQ ID NO: 1” and, therefore, anticipates claim 24. However, the Office admits that the sequence shown in Figure 501 of Rappuoli *et al.* was “published on the internet by the Centers for Disease Control” (“CDC Website Posting”). Even if the sequence shown in Figure 501 of Rappuoli *et al.* is the same as SEQ ID NO: 1, it is Applicants’ own work. Accordingly, Figure 501 of Rappuoli *et al.* is not “an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent” as required by 35 U.S.C. §102(e). In fact, far from anticipating claim 24, Rappuoli *et al.* establishes that Applicants had possession of the SEQ ID NO: 1 at least as early as April 14, 2003.

As suggested in the final Office action, filed herewith is a “Declaration of Paul A. Rota under 37 C.F.R. §1.132” (“Rota Declaration”), which “include[s] statements regarding . . .

deriv[ation] of the disclosed subject matter from the applicant.” In view of the Rota Declaration, Applicants respectfully request that the rejection of claim 24 under §102(e) be withdrawn.

Inventive Entity:

In the telephone interview (discussed in detail above), the Examiner mentioned that the CDC Website Posting may support a subsequent rejection of claim 24 under 35 U.S.C. §102(a) because the inventive entity of the present application differs from the author listing on the CDC Website Posting. In view of this reminder from the Examiner and in view of the cancellation of claims in response to the restriction requirement imposed by the Office, Applicants have particularly considered inventorship of claim 24, which is the only claim under examination in the present case.

As an initial matter, an “Amendment and Request to Delete the Names of Inventors under 37 C.F.R. §1.48(b)” (“Request”) has been submitted herewith to remove inventors of subject matter no longer claimed in the present application. The inventors to be removed are: Michael D. Bowen, Byron T. Cook, Jeannette Guarner, Richard F. Meyer, Christopher D. Paddock, and Wun-Ju Shieh.

Following entry of the Request, each of the authors listed on the CDC Website Posting (*i.e.*, Bellini, W.J., Campagnoli, R.P., Icenogle, J.P., Monroe, S.S., Nix, W.A., Oberste, M.S., Pallansch, M.A., and Rota, P.A.), and Larry J. Anderson, Cara Burns, Qi Chen, James A. Comer, Shannon Emery, Dean D. Erdman, Cynthia Goldsmith, Charles D. Humphrey, Thomas G. Ksiazek, Teresa C.T. Peret, Pierre E. Rollin, Anthony Sanchez, Suxiang Tong, and Sherif R. Zaki are inventors of the now-claimed subject matter. Each of the foregoing persons has signed the “Combined Declaration and Power of Attorney,” mailed to the USPTO on November 17, 2004, which is each person’s statement under penalty imposed by 18 U.S.C. §1001 that she or he is “an original, first and joint inventor of the subject matter which is claimed” in the application.

The Rota Declaration explains that the CDC Website Posting was uploaded by its authors on behalf of all of the persons now designated as inventors of the subject matter of claim 24. As explained in MPEP §715.01(c), “a [§102(a)] rejection based on a publication may be overcome

by a showing [under 37 C.F.R. §1.132] that it was published either by applicant himself/herself or on his/her behalf" (emphasis added). Therefore, further in view of the Rota Declaration, Applicants respectfully submit that the Office should not issue a rejection under 35 U.S.C. §102(a) citing the CDC Website Posting.

CONCLUSION

It is respectfully submitted that claim 24 is in a condition for allowance. If it may further issuance of a Notice of Allowance, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

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